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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,049	11/13/2006	David Morritz De Kretser	19721	5961

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GARDEN CITY, NY 11530

EXAMINER

HADDAD, MAHER M

ART UNIT	PAPER NUMBER
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1644

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08/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/575,049	Applicant(s) DE KRETZER ET AL.	
	Examiner Maher M. Haddad	Art Unit 1644	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 22 July 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: None.
- Claim(s) objected to: None.
- Claim(s) rejected: 1,2,5-7,10-12,18,19,23,26 and 30.
- Claim(s) withdrawn from consideration: 8,9,13-16,20-22 and 27-29.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Maher M. Haddad/
Primary Examiner, Art Unit 1644

Continuation of 11. does NOT place the application in condition for allowance because:

1. Claims 1, 2, 5-7, 10-12, 18, 19, 23 and 30 stand rejected under 35 U.S.C. 102(b) as being anticipated by US20030162715 for the same reasons set forth in the previous Office Action .
2. Claims 1, 2, 5-7, 10-12, 18, 19, 23, 26 and 30 59 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 03/006057 for the same reasons set forth in the previous Office Actions.
3. Claims 1, 2, 5-6, 10-11, 18, 19, 23, 26 and 30 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 8911862 for the same reasons set forth in the previous Office Action.
4. Claims 1, 2, 5-7, 10-12, 18, 19, 23, 26 and 30 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 20020192216 for the reasons set forth in the previous Office Action.

Applicant's arguments, filed 07/22/2010, have been fully considered, but have not been found convincing.

Applicant argument for the rejections above appears to concentrate on the mechanism of action of referenced "activin antagonist" in the recited method of treatment of a particular disease as claimed. However, the mechanism of action does not have a bearing on the patentability of the invention if the invention was already known or obvious. Even though applicant has proposed or claimed the mechanism by which inhibin alleviates symptoms of referenced diseases does not appear to distinguish the prior art teaching the same methods to achieve the same end result. Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In re Wiseman, 201 USPQ 658 (CCPA 1979). Granting a patent on the discovery of an unknown but inherent function would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art. In re Baxter Travenol Labs, 21 USPQ2d 1281 (Fed. Cir. 1991). See M.P.E.P. 2145.

5. Claims 1, 2, 5-7, 10-12, 18, 19, 23, 26 and 30 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's arguments, filed 07/22/2010, have been fully considered, but have not been found convincing.

Applicant draws that the Examiner's attention to the disclosure of the specification, particularly at page 31, et seq. commencing at line 9 (see, also particularly pp. 32 and 34). Specifically, "an activin antagonist" is well understood by one skilled in the art as a molecule which reduces the functionality or activity of a target. Various means are readily available to the skilled artisan to determine whether a candidate molecule is an activin antagonist. These features as well as an articulation of what is meant by proteinaceous and non- proteinaceous antagonists are provided at the cited disclosures. The skilled artisan would readily recognize that the inventors were in possession of the claimed invention at the relevant time.

However, it remains the Examiner's position that there is no described or art-recognized correlation or relationship between the structure of the invention, activin antagonists and it's anti-inflammatory function, the feature deemed essential to the instant invention. Therefore, one of skill in the art would not envisage, based on the instant disclosure, the claimed genus of activin antagonists which retain the features essential to the instant invention.